

**REMARKS**

Applicant traverses the rejections of record and requests reconsideration and withdraw of such in view of the remarks and amendments contained herein. Claims 35, 47, 49-53, 55, 57-58, 60, 63, 81, 85, and 88 have been amended. Claim 48 has been cancelled. Claims 35-47 and 49-96 are pending in this application.

**Rejection Under 35 U.S.C. § 112(1)**

Claims 35, 47, 85, and 88 are rejected under 35 U.S.C. 112, first paragraph, as “details pertaining to the steps involved with the captured music sample comparison against a music database are still absent from the claims.” (*see* Final Action, pg. 2).

Although the nature of the Examiner’s rejection is not entirely clear, as Applicant best understands, the Examiner views the claims as non-enabled for leaving out critical details. The Examiner makes a general reference to *In re Mayhew*, 527 F.2d 1229, 188 U.S.P.Q. 356 (CCPA 1976) in support of his rejection. The Applicant respectfully submits that *In re Mayhew* does not apply to the case at hand. *In re Mayhew* involves a set of claims that wholly fail to recite “essential steps in the inventive process.” *Id.* at 1232. Specifically, the *In re Mayhew* court determined that claims which fail to recite the use of a cooling zone, specifically located, are not supported by an enabling disclosure, where the applicant disclosed such a cooling zone as essential to his invention. Applicant’s specification makes no such claim of essential elements required to practice the invention. Applicant believes the claims are definite and enabled by the specification in accordance with 35 U.S.C. 112, first paragraph. Claim 47, for example, recites:

“comparing the characteristic of the captured sample to a characteristic associated with an identity records contained in a database.”

Such “comparing” is discussed at length in the specification. *see*, for example, pgs. 29-34, 41-51. The Applicant discloses a preferred embodiment of “comparing” in specification; however, the preferred method of comparing is not necessarily the only method of comparing. As such, each claim of the in the present application is supported by an enabling disclosure as required by 35 U.S.C. 112, first paragraph.

Applicant can find no rationale to support the Examiner's assertion that this element, or a similar one, "must recites essential elements." If the Examiner believes that "details critical to the practice of the invention" are absent from the claims, Applicant requests that the Examiner provide some basis for his remarks. In view of the above, the Applicant respectfully submits that the claims are enabled under 35 U.S.C. 112, first paragraph, and requests withdrawal of the 35 U.S.C. § 112 rejection of record.

If, in fact, the Examiner views the claims as indefinite under 35 U.S.C. 112, second paragraph, Applicant respectfully points out that breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and Applicant has not indicated that the scope of the invention is different from the defined claims, then the claims are definite. *see* M.P.E.P. § 2173.04. Again, Applicant respectfully points out that, for example, claim 47 recites:

"comparing the characteristic of the captured sample to a characteristic associated with an identity records contained in a database."

As shown, Applicant has provided sufficient detail with respect to comparing a captured sample to records in a database. Also, such a comparison is discussed at length in the specification. Applicant has not given any indication that the scope of the invention is anything other than that which is claimed; therefore, the scope of the claimed subject matter is clear.

### **Rejection Under 35 U.S.C. § 102(b)**

Claims 35-44 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,125,024 to Gokcen et al (hereinafter "Gokcen").

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *see* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *see* M.P.E.P. § 2131; citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, "[t]he

identical invention must be shown in as complete detail as is contained in the . . . claim.” *see* M.P.E.P. § 2131; *citing Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 35, as amended, recites a method for providing a transaction to a user exposed to a media stream, comprising receiving a signal including a captured sample of a media stream from the user, said media stream comprising music. Gokcen merely teaches receiving a user voice command at a speech recognizer. The speech recognizer responds to the received command by prompting a voice response unit to initiate further procedures with a user. *see* Gokcen col. 5 line 60- col. 6 line 5. As such, Gokcen does not teach receiving a signal including a captured sample. Instead, Gokcen teaches receiving a voice command, such as a numerical 1, in its entirety. Gokcen requires transmission and receipt of the complete command in order to formulate a response by the voice response unit. For instance, if the user provided merely a “sample” of the voice command, such as speaking only the first half of the numerical one, Gokcen would be useless. Put simply, Gokcen does not function if only a sample of a media stream is received. The disclosure of Gokcen makes clear that Gokcen expects, and must receive a complete spoken word corresponding to its small library of words. If Gokcen receives only a sample, the speech recognition system remains idle. Gokcen, at col. 6 lines 27-30, states “if speech recognizer 13 does not recognize the customer command, the voice prompt message continues to be sent to the calling customer.” As such, Gokcen does not teach receiving a signal including a captured sample. Moreover, Gokcen does not teach a captured sample of a media stream comprising music. Clearly, a spoken voice command is not a media sample, and certainly does not comprise music.

Claim 35 also recites “triggering a predetermined transaction with the user involving the music in response to the determined characteristic.” Gokcen discloses that a customer may verbally speak a command into a telephone to place an order from a department store. The numeral command (i.e., “number 1”) is applied to a speech recognizer to initiate a transaction. *see* Gokcen col. 5 lines 39-45; col. 5 line 60- col. 6 line 5. As such, any transaction of Gokcen, such as the purchase of a department store item, does not involve music. Taken further, any transaction of Gokcen does not involve that which is transmitted by the user, the user’s voice command. The transactions contemplated by Gokcen do not involve the voice commands issued by a user of Gokcen. The user, for example, never seeks to purchase a “one.” However, in the Applicant’s invention the predetermined transaction

involves the substance of what the user plays over the transmission line, namely the music. As shown, Gokcen does not teach every element of Applicant's invention. Therefore, Gokcen does not teach triggering a predetermined transaction, involving the music, as recited in claim 35.

Claims 36-44 depend from claim 35 and inherit each claim element therefrom. As such, claims 36-44 set forth elements not taught by Gokcen. Therefore, claims 36-44 are patentable at least for the reasons set forth above with respect to claim 35.

### **Rejection Under 35 U.S.C. § 103(a)**

Claims 45-96 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gokcen in view of U.S. Patent No. 5,661,787 to Pocock (hereinafter "Pocock").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim elements. *See* M.P.E.P. § 2143. Without conceding that the first or second criteria are satisfied, Applicant respectfully asserts that the Examiner's rejection fails to satisfy at least the third criteria.

Claim 47 recites "receiving a signal including a captured sample of the music from the user; wherein the music is received by the user via radio broadcast and the captured sample includes a sample of the radio broadcast." In the Final Action, the Examiner attempts to satisfy this element by pointing to Gokcen's voice response unit and merely stating "A voice sample is an audio sample and is equivalent to the claimed radio broadcast sample." (*see* Final Action, paragraph 14). The Applicant respectfully disagrees. Gokcen discloses that a customer may verbally speak a command into a telephone to place an order. The numeral command is applied to a speech recognizer to initiate a transaction. *see* Gokcen col. 5 lines 39-45; col. 5 line 60- col. 6 line 5. As mentioned above, the Examiner equates a user voice sample to the claim element; however, the Examiner's assertion is incorrect. Even if Gokcen's user voice sample could be construed as "a captured sample of music," which Applicant does not concede as true, a voice sample cannot not satisfy this element. The claim

element also recites “wherein the music is received by the user via radio broadcast and the captured sample includes a sample of the radio broadcast.” A voice sample does not satisfy this element; that is, a user voice sample does not teach anything received by the user, much less “music received by the user via radio broadcast.” A user cannot receive his own voice sample via a radio broadcast. Moreover, comparing a user voice sample to a sample of the radio broadcast is nonsensical. A user voice sample merely contains the user’s own voice, not a sample of radio broadcast. Pocock is not relied upon to teach or suggest this claim element; and Pocock does not do so. Instead, Pocock describes a user calling a phone number to listen to a broadcast information. The user can then initiate a song purchase after receiving the broadcast information by voice input or keypad input. (see Pocock col. 2 lines 51-60). As shown, the Examiner’s proposed combination fails to teach or suggest every claim element of Applicant’s invention. Therefore, Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

Claims 49-84 depend from claim 47 and thereby inherit each element therefrom. As shown above, the combination of Gokcen and Pocock fails to teach or suggest receiving a signal including a captured sample of the music from the user; wherein the music is received by the user via radio broadcast and the captured sample includes a sample of the radio broadcast as recited in claim 47. As such, claims 49-84 set forth elements not taught or suggested by the Examiner’s proposed combination. Therefore, claims 49-84 are patentable at least for the reasons set forth above with respect to claim 47. Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

Claim 60 recites “downloading media to a user device.” In the Final Action, the Examiner attempts to satisfy this element simply by stating “it is inherent that media is downloadable as claimed, when a phone with Internet access is used.” (*see* Final Action, paragraph 27). The Applicant respectfully disagrees with the Examiner’s apparent understanding of the references. Gokcen requires that a user verbally speak a numerical command into the hand set of the telephone. *see* Gokcen col. 5 lines 39-42. Pocock requires a purchaser to call a phone number and listen to broadcast information to select music for purchase. *see* Pocock col. 2 lines 51-55; Abstract. As such, Gokcen and Pocock each require that a user employ a phone line in conjunction with a telephone, not a computer via internet. Moreover, Gokcen was filed in 1990 and Pocock was filed in 1994, well before the internet

was widely used at the consumer level. Therefore, it is unlikely that use of the internet was even contemplated by either of Gokcen or Pocock; notably, mention of the Internet is wholly absent from either disclosure. As shown, the Examiner's proposed combination fails to teach or suggest every claim element of Applicant's invention. Therefore, Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

Claims 61-62, 64-80, and 82-84 depend from claim 60 and thereby inherit each element therefrom. As shown above, the combination of Gokcen and Pocock fails to teach or suggest downloading media to a user device as recited in claim 60. As such, claims 61-62, 64-80, and 82-84 set forth elements not taught or suggested by the Examiner's proposed combination. Therefore, claims 61-62, 64-80, and 82-84 are patentable at least for the reasons set forth above with respect to claim 60. Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

Claims 85 and 88 recite a method for identifying music to a user exposed to a broadcast that includes unidentified music, comprising receiving a signal including a captured sample of the broadcast from the user, said broadcast comprising music. As shown above with respect to claim 35, Gokcen does not teach or suggest receiving a signal including a captured sample of the broadcast from the user said broadcast comprising music as recited in claim 85. Moreover, Pocock is not relied upon to teach or suggest this missing element. As such, the Examiner's proposed combination fails to teach or suggest each element of Applicant's invention. Therefore, Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

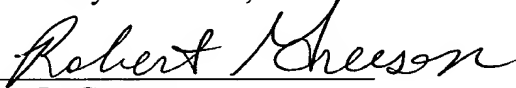
Claims 86-87 and 89-96 depend from claims 85 and 88, respectively, and thereby inherit each element therefrom. As shown above, the combination of Gokcen and Pocock fails to teach or suggest each element of claims 85 and 88. As such, claims 86-87 and 89-96 set forth elements not taught or suggested by the Examiner's proposed combination. Therefore, claims 86-87 and 89-96 are patentable at least for the reasons set forth above with respect to claims 85 and 88. Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

**Conclusion**

In view of the above the remarks and amendments above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 69323/P002US/10511081 from which the undersigned is authorized to draw.

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Respectfully submitted,

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